

REMARKS

An office action dated July 23, 2004 was initially issued for the present application. This office action was never received by the Applicant, and was returned to the USPTO as undeliverable on July 29, 2004. In a telephone conversation with the Examiner on January 4, 2005, the representative of the Applicant requested that the unreceived office action be withdrawn and reissued with a new date. The Examiner agreed to do so, and reissued the office action on January 7, 2005.

This application contains claims 1-40, the status of which is as follows:

(a) Claims 1-20 have been canceled. The Applicant may prosecute these claims in a continuation application.

(b) Claims 21-23 are as originally filed.

(c) Claims 24-40 are new.

No new matter has been added. Reconsideration is respectfully requested.

Claims 1-4 and 14-17 were rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,628,306 to Marchionda. Claims 8-13 and 18-20 were rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,327,612 to Watanabe. Claims 5-7 and 18-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Marchionda in view of Watanabe. While respectfully disagreeing with the Examiner's grounds for rejection, the Applicant has canceled these claims in order to expedite issuance of a patent on other claims the Applicant believes to be allowable, as discussed hereinbelow. The Applicant may prosecute these canceled claims in a continuation application.

Claims 21 and 23 were rejected under 35 U.S.C. 102(e) as being anticipated by Watanabe. The Examiner stated, "Watanabe teaches . . . receiving as input from the sender an instruction indicative of whether to save the attachment (See col. 3, lines 58-62); sending the e-mail message and the attachment to the recipient; and responsive to the instruction indicating not to save the attachment, saving the e-mail message without the attachment (See col. 3, lines 1-13)" (section 3g of the Office Action). The Applicant respectfully submits that claims 21 and 23 claims are not anticipated by Watanabe. Col. 3, lines 58-62 of Watanabe, which was cited by the Examiner, reads:

The attachment file accepting means is responsive to a user's manipulation, for example, for accepting one or more attachment files to be attached to

the e-mails that are solely destined for the primary recipients identified by said TO addresses, and for recording the attachment files onto a recording medium such as a hard disk.

Watanabe describes recording attachment files that are to be attached to e-mails. From this, the Examiner inferred that pursuant to the techniques of Watanabe, attachment files that are *not* to be attached to e-mails are *not* recorded. In contrast, claims 21 and 23 of the present application recite *not* saving an attachment which *is* sent to a recipient. Watanabe nowhere describes or suggests sending an e-mail message *with* an attachment, and saving said e-mail message *without* said attachment.

Claim 22 was rejected under 35 U.S.C. 102(e) as being anticipated by Watanabe. The Examiner stated, "Watanabe teaches . . . a processor, arranged to receive from a sender an instruction indicative of whether to save the attachment, arranged to actuate the data port to send the e-mail message and the attachment to a recipient, and arranged to save the e-mail message in the memory without the attachment responsive to the instruction indicating not to save the attachment (See col. 15, lines 1-34)" (section 3h of the Office Action). The Applicant respectfully submits that claim 22 is not anticipated by Watanabe, for the same reasons given above with respect to claims 21 and 23.

US Patent 6,256,672 to Redpath and US Patent 5,903,723 to Beck et al. were made of record and not relied upon by the Examiner. The Applicant has reviewed these references, and does not believe that any of claims 21-23 read upon these references.

In light of these arguments, the Applicant respectfully submits that independent claims 21-23 of the present application are allowable. New dependent claims 24-29, 30-34, and 35-40 depend, directly or indirectly, from independent claims 21-23, respectively. In light of the suggested patentability of these independent claims, the Applicant respectfully submits that these dependent claims are allowable, being of narrower scope than the independent claims from which they depend.

Claims 24-40 are new. These new claims are supported in the Applicant's specification, including in the following paragraph:

Alternatively or additionally, preferred embodiments of the present invention enable the user to conserve system resources by designating, at the time of writing or sending an e-mail message, whether a file attached thereto should be saved on the user's computer (as is the default setting of most e-mail programs), or whether only the e-mail message should be saved. Preferably, if the user chooses not to save the attached file with the e-mail message, then the name of the attached file and/or other identifying information is saved with the message. It will be appreciated that these embodiments can operate in conjunction with or separately from the embodiments of the present invention in which the user designates which recipients should receive a given attachment (p. 4, line 22 – p. 5, line 4).

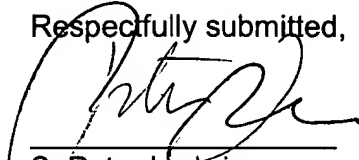
More specifically, claims 24-40 are respectively supported in the following excerpts from this paragraph:

Claims	Excerpt
24 and 35	"should be saved on the user's computer"
25, 26, 30, 31, 36, and 37	"at the time of writing or sending an e-mail message"
27, 28, 32, 33, 38, and 39	"the name of the attached file and/or other identifying information is saved with the message"
29, 34, and 40	"It will be appreciated that these embodiments can operate in conjunction with or separately from the embodiments of the present invention in which the user designates which recipients should receive a given attachment."

The Applicant believes the amendments and remarks presented hereinabove to be fully responsive to all of the grounds of rejection raised by the Examiner. In view of these amendments and remarks, the Applicant respectfully submits that all of the claims in the present application are now in order for allowance. Notice to this effect is respectfully requested.

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Respectfully submitted,



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